

IV. AMENDMENTS TO THE DRAWINGS

--- Replacement and annotated mark-up drawing sheets for amended figures showing the amended figures, if any, are attached at the Appendix hereto. Each figure is in compliance with 37 C.F.R. § 1.84. An explanation of the changes, if any, is set forth below in this "Amendments to the Drawings" section. Replacement drawing sheets are identified in the top margin as "Replacement Sheet." Any replacement drawing sheet including amended figures includes all of the figures appearing on the immediate prior version of the sheet. Any annotated drawing sheets, if the same are required by the Examiner, are identified in the top margin as "Annotated Marked-Up Drawings." Any deleted figure is noted by an instruction to delete the figure. Any corresponding amendment to the specification necessary to be made because of an amendment to the drawings in this section is made in the corresponding "Amendments to Specification" section.

- THE DRAWINGS OF THE PATENT IS HEREBY AMENDED AS SET FORTH BELOW:
 - Re-drafted FIGS. 1 – 3 are attached at the Appendix.

V. REMARKS/ARGUMENTS

- STATUS OF THE CLAIMS

Claims 1 – 20 are pending in this application. Claims 1 – 18 have been withdrawn from consideration pursuant to the restriction requirement discussed below. Claims 19 and 20 are amended herein. Support for such amendments is found in the specification at paragraphs [00082] – [00084] among other places.

- OBJECTIONS

- OBJECTIONS TO THE SPECIFICATION

- Examiner's Stance

The Examiner objects to the use of the trademark “Macrovision” in the specification. The Examiner indicates that the trademark should be capitalized wherever it appears, and that the mark “be accompanied by the generic terminology.” The Examiner further indicates that the left side of page 22 is missing.

- Applicants' Response

Applicants respectfully traverse the Examiner’s objections to the specification in part based on Applicants’ assertion that a person of ordinary skill in the art would clearly recognize the trademark use of “Macrovision” in the specification, and because Applicants note no missing “left side” on page 22 of the specification as submitted. However, Applicants assert that such objections are mooted by Applicants’ amendment to the specification set forth above.

- OBJECTIONS TO THE DRAWINGS

- Examiner's Stance

The Examiner objects to the drawings because “several labels are difficult to see/read.” The Examiner specifically recites “a’, b’, c’, d” of FIG. 3 as being unclear.

- Applicants' Response

Applicants respectfully traverse the Examiner’s objections to the drawings, asserting that such are clear. However, Applicants have herein provided re-drafted drawings which they assert overcome all of the Examiner’s objections.

RESTRICTION REQUIREMENT UNDER 35 U.S.C. §121

- MAKING OF SUCH REQUIREMENT FINAL

- Examiner's Stance

The Examiner notes Applicants’ provisional election (which was with traverse) of Group IV, claims 19 – 20. The Examiner asserts that claim sets 1 – 7, 8 – 13, 14 – 18, and 19 – 20 assert distinct inventions from one another, being “related as subcombinations … usable together in a single combination,” yet “separately usable” (*see*, page 2, point 2 of the Office Action). The Examiner asserts “[b]ecause these inventions are distinct … and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes … is proper.”

- Applicants' Response

Applicants respectfully traverse the Examiner’s restriction requirement in part based on the argument that the search and examination of the entire original claims presented can be made without serious burden.

Applicants confirm that their attorney made a provisional election to prosecute the invention of Group IV, *viz* claims 19 and 20. Affirmation of this election is made herein.

Applicants note that upon cancellation of claims to a non-elected invention, inventorship must be amended if one or more of the currently named inventors is no longer

an inventor of at least one claim remaining in the invention. Should the Examiner make the restriction requirement final, a request under 37 C.F.R. 1.48(b) is attached at the Appendix hereto correcting inventorship as to the pending claims.

- ASSERTION OF NON-COMPLIANT AMENDMENT UNDER 37 C.F.R. §1.121
 - Failure to Comply with 37 C.F.R. §1.111(b)
 - Examiner's Stance

The Examiner has asserted that the reply filed April 18, 2006 in respect to the Office Action mailed October 18, 2005 was deficient in not complying with 37 C.F.R. §1.111(b) because “Applicant’s arguments … amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes from the references.” The Examiner argues that Applicants have not presented their “own arguments with regards to the claim language presented.”

- Applicants' Response

Applicants respectfully traverse the Examiner’s issuance of a non-compliant amendment. Applicants assert that the amendment and response of April 18, 2006 was fully compliant. Applicants, however, have fully reviewed 37 C.F.R. §1.111 and M.P.E.P. §714.02, and have attempted to meet the Examiner’s objections with respect to the prior amendment herein. Applicants have earnestly attempted to develop a clear issue for the Examiner. The Examiner is hereby respectfully requested to immediately call the Applicants’ representative set forth below, if the Examiner finds this Amendment and Response in any way deficient, so appropriate correction can be immediately made.

- REJECTIONS
 - Rejection Under 35 U.S.C. §102(a) and (e)
 - Examiner's Stance

The Examiner has rejected unamended claims 19 and 20 under 35 U.S.C. §102(a) and (e) as being anticipated by U.S. Patent No. 6,477,124 to Carson. The Examiner asserts that the Carson reference teaches each and every element of unamended claims 19 and 20.

• Applicants' Response

Applicants note once more their interference request dated August 21, 2003 which was filed against (in part) unamended claims 1 and 56 of U.S. Patent Application Serial No. 10/062,400 which present claims 19 and 20 parallel.

Applicants respectfully traverse the rejection of unamended claims 19 – 20 under 35 U.S.C. §102(a) and (e) asserting in part that the Examiner has failed to point out corresponding disclosure to each and every element present in the amended claims that may be found in the art of reference.

Applicants have amended claims 19 and 20 to make clear that reference to a “monitoring of a transfer rate of read-data” relates to the rate of transfer of the data coming from the media read device to a computing device. Both claims have also been amended to recite that the anomaly region is determined at the computing device level by identifying a modification in the transfer rate of such data at such anomaly region from other regions surrounding such anomaly region on the digital medium. Applicants assert that amendments to claims 19 and 20 made herein obviate such 35 U.S.C. §102 (a) and (e) rejections in that the new elements added are not specifically found in the reference. Applicants respectfully request that if the Examiner asserts that such disclosure is found in U.S. Patent No. 6,477,124 to Carson that under 37 C.F.R. §1.104 (c) (2) (M.P.E.P. §707), the Examiner point to “the particular part relied on” in a manner to “designate [the same] as nearly as practicable” given the complexity of the reference.

Applicants respectfully assert that the disclosure of U.S. Patent No. 6,477,124 to Carson is silent as to the monitored transfer rate therein being tantamount to the monitoring of transfer rate as set forth in the amended claims. Applicants respectfully request that the pertinence of citations to “Figure 3[block 140], column 6, lines 52 – 55; column 8, lines 15 – 32, and claims 5 & 7” be set forth in a clear manner by the Examiner pursuant to 37 C.F.R. §1.104 (M.P.E.P. §707). Applicants note such disclosure appears from the specification to relate to a data rate measured during readback, not as set forth in the amended claims. Therefore, Applicants respectfully assert that the Examiner has failed to make a *prime facie* case of anticipation in light of the presently amended claims.

Applicants note that the Examiner's rejections are not based in obviousness, but rather anticipation. As the Federal Circuit has "repeatedly stated, anticipation requires that each limitation of a claim must be found in a single reference" *Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 63 U.S.P.Q.2d 1374 (Fed. Cir. 2002). The absence from a cited reference of any element of a claim of a patent negates anticipation of the claim by the reference. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986), *on rehearing*, 231 U.S.P.Q. 160 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 1034 (1987). Applicants assert that the material added by amendment to the present claims aids in clarifying the difference between the transfer rate monitoring of the present claims and the prior art of reference. Therefore, claims 19 and 20 cannot be said to be anticipated by the reference under 35 U.S.C. §102 (a) or (e).

CONCLUSION TO REMARKS

Applicants assert that this response is fully responsive to the Examiner's Office Action dated October 18, 2005 and the Examiner's Notice of Non-Compliant Amendment of May 31, 2006. Applicants respectfully seek early allowance of the pending claims.

Respectfully Submitted,



Steven J. Moore, Reg. No. 35,959
Attorneys for Applicants
Kelley Drye & Warren LLP
Two Stamford Plaza
281 Tresser Boulevard
Stamford, CT 06901-3229

VI. APPENDIX

- A “Request under 37 C.F.R. § 1.48(b) to Correct Inventorship Pursuant to 35 U.S.C. § 116”
- FIGS. 1 – 3